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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,529	12/22/2000	James M. Sheppard JR.	2827	2077

7590

07/14/2005

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,529

Applicant(s)

SHEPPARD, JAMES M.

Examiner

Jenna-Leigh Befumo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of the Appeal Brief filed on April 21, 2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The 35 USC 103 rejection based on Hobson (4,259,994) in view of Carpenter et al. (5,983,952) and Sherrill et al. (3,721,273) is withdrawn since Hobson does not teach having a woven design on both the front and back on the towel, but instead is producing two different towels with different colored designs next to each other on a single loom.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 21 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark (3,669,818) in view of Parker et al. (1,925,459).

Alternatively, claims 21 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. in view of Stark.

Stark discloses a pile fabric having a patterned surface and a design superimposed on the patterned surface for use in carpets, towels, and upholstery (abstract). Further, Stark discloses that there is a continuing desire in the textile field to produce new and aesthetically pleasing textile products (column 1, lines 25 – 29). Various patterns may be produced in the textile fabric itself by varying the construction of the pile surface and using different color yarns to create various parts or sections of the fabrics (column 1, lines 29 – 31 and 40 – 45). Further, Stark discloses that it is known in the art to print patterned pile fabrics in registry with sections of the existing pattern (column 1, lines 45 – 47). The pile fabric can be produced by conventional means, including weaving, to produce a desired pattern in the fabric (column 2, lines 13 – 15). The printing can be applied by various methods including roller printing, screen printing, photographic printing or the like (column 2, lines 22 – 25). And the printed design can include multiple colors onto fabrics made from different colored yarns (column 2, lines 23 – 28). Additionally, the pile yarns can be looped yarns or cut yarns (column 2, lines 29 – 30). When the looped yarns are cut, the process inherently releases tension in the yarn and allows the fibers to spread open to some degree. Finally, Stark discloses that the particular pile pattern used to make the fabric is virtually unlimited, as is the print design to be applied to the fabric, and the final product is governed by the desired visual appearance (column 2, lines 43 – 47).

While Stark discloses fabrics made with different color yarns, Stark fails to teach patterned pile fabrics having a woven two-color design on a first side and the reverse design on the opposite side. Parker et al. is drawn to pile fabrics comprising a woven pattern produced by using contrasting yarns (lines 1 – 5). Stark discloses that the patterned fabric is made up of two different color pile yarns using a first color yarn to form the background of the design and a

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second color to form the image of the design on the first side of the fabric, while the second side of the fabric is the reverse with the first color forming the image and the second color forming the background (lines 15 – 25). The different colored yarns can be used to form stripes or other designs (lines 13 – 15). Also, the filling yarns can be different colors creating cross borders, or transverse stripes, in the fabric, with the opposite side being a reverse image (lines 28 – 35). Thus, it would have been obvious to one having ordinary skill in the art to use a pile fabric having a first image on the first side and a reverse image on the second side, as disclosed by Parker et al. as the patterned pile fabric in the printed pile fabric disclosed by Stark since Parker et al. discloses a woven patterned pile fabric and Stark discloses that a printed design can be combined with a patterned pile fabric of any construction to produce a visually appealing finished product.

Alternatively, Parker et al. fails to teach adding a printed design to the patterned, pile fabric. As set forth above, Stark discloses that it is known in the art to add printed designs to pile fabric to produce new finished products which are aesthetically attractive to the consumer. Hence, it would have been obvious to one having ordinary skill in the art to add a printed design as disclosed by Stark to the patterned fabric taught by Parker et al. because fabric taught by Parker et al. can be enriched by applying a printed pattern to the fabric which enhances the desirability of the end product (Stark, column 2, lines 48 – 50).

While Stark and Parker do not teach specific design patterns, i.e., the specific features of a towel having borders at each edge and a central area where the printing is applied, both Stark and Parker acknowledge that various woven and printed designs are known and can be combined together to form any desired visual appearance. Further, the claimed border feature is created by

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controlling the location of the colored yarns, and not by changing the overall weave structure of the towel or by adding additional components to the towel. As set forth in § MPEP 1502.01 a “utility patent” protects the way an article is used and works, while a “design patent” protects the way an article looks (35 U.S.C. 171). The ornamental appearance for an article includes its shape, configuration, and/or surface ornamentation applied to the article. The design pattern created by the two yarns in the woven towel controls the way the fabric looks and does not effect the structure of the towel or the way the towel is used. The towel is still made from multiple warp and weft yarns which are woven together to produce a standard terry cloth fabric, even if the yarns used to make the towel are all one color or all different colors. Hence, the pattern of the colored yarns only effects the ornamentation of the fabric and has no effect on the actual structure of the towel.

It has been held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Further, it has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983). In this case, it is felt that there is no functional relationship between the pattern of the colored yarns, i.e., forming a border on each edge, and the woven towel with printing. Because regardless of what color the two sections are, the structure of the towel and how the towel works will not be changed. The only difference between a towel with a blue border section and a white center

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section on the first side, and a towel with a black border section and a yellow center section on the first side, is the appearance of the towel. Even if the towel was a single color or had multiple stripes, instead of a border section on each edge, the towel would still function the same way and have the same structure, i.e., a woven terry cloth towel with a printed design. Hence, the actual design, or location, of the different colored yarns recited in the independent claims is not given patentable weight because it is not functionally related to the substrate and does not distinguish the invention from the prior art in terms of patentability.

Further, it is noted that the applicant's limitations that the fabric is produced on a jacquard loom is an apparatus limitation which is not given patentable weight in the product claim. The patentability of the product is based on the structural limitations of that product and not how it is made or what machine is used to make it. Thus, if the claimed product can be made on a different apparatus or by a different process, the claim is unpatentable even though the prior product was made by a different process or apparatus.

Therefore, the claimed features which deserve patentable weight are, the woven towel having two different color yarns which create a first pattern on the a first side and an inverse pattern on the reverse side, with a graphic impression printed on one side. And as set forth above, these features are taught by Stark and Parker et al. And with respect to choosing different towel designs and combining printed designs with woven designs, Stark discloses combining weave designs with printed designs to create various towel products and further teaches it is known to apply the printed design in registry with the pattern of the towel. Additionally, Parker et al discloses that different color yarns can be used to produce different color sections in the towel with a reverse image on the opposite side of the towel. Further, the prior art references

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also disclose that the patterns which can be used to produce the towel design are virtually unlimited. Thus, the prior art teaches applying print to multi-color patterned towels based on the woven pattern of the towel and that patterned towels with a first image on one side and a reverse image on the opposite side are known. Claims 21 – 36 are rejected.

5. Claims 21 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark and Parker et al., as set forth above, and in further view of Sherrill et al.

The features of Stark and Parker et al. have been set forth above. The exact design and printed image have not been given patentable weight. In the event that the specific design and printed image are given patentable weight Sherrill et al. is included in the rejection as evidence that the design claimed by applicant, a border region surrounding a center area with a design or graphic, is known to those in the art.

Sherrill et al. is drawn to printed terry cloth towel products. As shown in Figure 1, the towel is produced with the border design on all four edges and a image in the central area created by the border. Thus, Sherrill et al. discloses that the design pattern desired by the applicant, i.e., a border design on all four edges of the towel and image in the center portion of the towel, is known to those in the art.

Therefore, it would have been obvious to one of ordinary skill in the art to create towels with a known design structure, as shown in Sherrill et al., by combining woven patterns with printed patterns as taught in Stark and Parker et al., which teaches creating towels with different colored sections combined with printed patterns to produce a desired finished product. Also, this would create a towel that is visually and texturally appealing due to the printed images, colors, and weave structure. Thus, claims 21 – 36 are rejected.

Response to Arguments

6. Applicant's arguments filed April 21, 2005 have been fully considered but they are not persuasive. With respect to the applicant's arguments addressing the affidavit's filed to show evidence of commercial success and long felt need (appeal brief, pages 12 – 16) it is noted that the Examiner's Answer mailed August 27, 2003 addressed more specifically those same arguments, but some of the comments will be further addressed below.

First, it is noted that the applicant was not accused of lying in the previous responses. Instead, the declaration filed by the applicant was considered to be the applicant's opinion without sufficient evidence to support the opinion. Thus, while the opinion was considered, when considered in light of the state of the art, the interest of the expert in the outcome of the case, and the presence or absence of factual evidence to support the opinion (see §MPEP 716.01 (c) III), the declaration was not found sufficient enough to withdraw the rejections of record.

Further, there was not sufficient support in the evidence provided by the applicant to show commercial success, because there was nothing to show that the reason for the increase of sales and the increased profit of these towels is due to the nature of the claimed product, i.e., the fact that the applicant applied a printed image to two-tone towel, and not due to other factors such as the marketing of the towel, a lower price to make the towel, a higher mark-up in price than the other products, or production decisions to not produce more expensive products. Also, the exact structure of the towels which are referred to as the Edge Hand towel, the Edge Pro towel, and the Edge Beach towel have not been defined by the applicant. Thus, it is unclear if the products which produced sales figures presented by the applicant have the same scope as the claimed product. The evidence of commercial success must be commensurate in scope with the

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claims (see §MPEP 716.03 (a) I). Further, commercial success must be directly derived from the claimed invention and not the result of heavy promotion or advertising, consumption by purchasers normally tied to an applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli* 470 F.2d 1380, 176 USPQ 305 (CCPA 1973). Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Finally, it has been held that gross sales figures do not show commercial success absent evidence as to the market share. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015 226 USPQ 881 (Fed. Cir. 1985).

Additionally, it is noted that the affidavit filed November 21, 2002 has other shortcomings. First, it is noted that the affidavit states (as well as the applicant's disclosure and specification) that jacquard woven fabrics are limited to two colors in any linear direction. This is not completely true. While golf towels may be traditionally made with only two colors in any linear direction, jacquard fabrics can be made with more than two colors as evidenced by Parker et al. and jacquard weaving is used to make tapestry fabrics which reproduce a image with multiple colors in a woven fabric. Even though jacquard woven fabrics are not true tapestries the process can be used to produce a similar looking product.

Further, the applicant specifically describes using image dying to produce the printed image. However, the independent claims and the claims which further limit the printing process are not limited to only image dying. Hence, the product discussed in the affidavit is not commensurate in scope with the current claims. Also the applicant discusses that the image is applied to a sheared surface to produce enhanced clarity and resolution in the printed image. The

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independent claim does not require a sheared surface or address the resolution of the image.

Finally, the applicant states that the printed image can be overprinted on the center portion because the dark border prevents the printing from being seen. However, neither the overprinting or the limitation that the border is a darker color than the center area which is printed is recited in the independent claim. Thus, the affidavits are not commensurate in scope to the claimed product and cannot be used to show nonobviousness of the claimed product.

Also, the applicant's statement that applying an inexpensive printing process to an expensive towel would cheapen the value of the towel is the applicant's opinion which is not supported by fact. Adding an inexpensive finishing step such as printing would help to keep the price of the product as low as possible while increasing the number of designs which can be produced. The prior art such as Stark, Sherrill, Carpenter et al. (5,983,952), Hobson (4,259,994) and Kaufman (5,486,500) show that applying printed designs to various towels and pile fabrics is indeed desired in the art and well known in the art. Particularly, Stark discloses that combining a printed image with a patterned fabric (which would be considered an expensive or high end pile fabric) is known and desired due to the unlimited number of designs and visual effects which can be created by combining the two types of design features.

The applicant also addresses that the combination produces a graphic image which was unexpectedly more crisp and sharp than images on other towels. This result is due perhaps to the plushness of the sheared pile. However, the prior art not only addresses towels structures which produce improved images, but also printing processes which produce better images. Specifically, Sherrill et al. discusses using a sheared surface for producing a sharper image due to the smooth surface of the cut pile versus the loop pile (column 4, lines 18 – 25). Hence the thicker and

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smoother the printing surface the better the resolution of the image will be. Further, Kaufman discloses that the actual printing process is also critical to producing a multi-color image with high definition such as a reproduction of photographs (abstract). Kaufman teaches that a sublimation printing process can be used to produce a high definition image on any towel fabric and maintain absorbency at the same time (column 1, lines 52 – 65 and (column 2, lines 30 – 35).

With regard to the applicant's evidence to show long-felt need, establishing long-felt need *requires* objective evidence that an art recognized problem existed in the art for a long period of time without solution (see §MPEP 716.04). The applicant provided no evidence to show this was in fact a problem than was recognized in the art or that others had been trying to solve the same problem unsuccessfully.

With respect to the applicant's evidence of copying, more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors (see §MPEP 716.06). Alleged copying is not persuasive of nonobviousness when the other manufacturer had not expended great effort to develop its own solution. *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985).

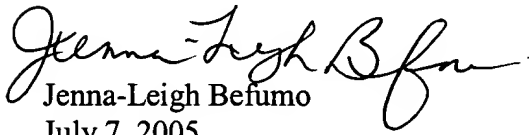
Conclusion

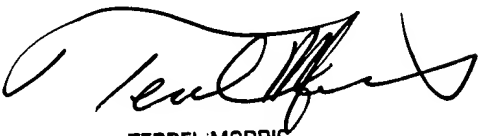
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jenna-Leigh Befumo
July 7, 2005


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